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K 416180CIP

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121

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10/04/89

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire THREE month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>INTERVIEW SUMMARY, FORM PTO-413</u> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-20 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☒ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Art Unit 121

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1 to 20 are rejected under 35 U.S.C. 102e as being clearly anticipated by Bosies et al (USP 4,777,163).

Note the claims. Applicants are required to furnish an English language translation of their Swiss priority document (which itself has yet to be filed). However note MPEP 2308.03.

Claims 1 to 20 are rejected under 35 U.S.C. 103 as being unpatentable over EPO 186,405 in view of Bosies et al (USP 4,687,767).

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EPO discloses the pyridyl analogs of the claimed compounds. See page 9, lines 32 to 35, e.g. Bosies equates pyridyl and other heterocyclic moieties in a closely related system with like utility (also applicants' utility). Substitution of equivalents into the EPO compounds would be obvious.

Claims 1 to 3, 6, 15, 19 and 20 are rejected under 35 U.S.C. 103 as being unpatentable over the CA reference (AR).

See III which is an adjacent homolog of applicants' compounds which compounds are prima facie obvious thereover. Please provide a copy of the German Patent which is abstracted.

Claims 1 to 6, 19 and 20 are rejected under 35 U.S.C. 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "in particular" should be ^vrescoped for the specification, since it causes the claims to read on a genus and subgenus simultaneously. Composition claims should recite an intended use and an amount of active

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Art Unit 121

ingredient. Functional language will suffice. Method claims should recite a ~~host~~ and an amount. Applicants are required to point out or to provide the antecedent basis for claims 4 and ⁵37 CFR 1.75(d)(1).

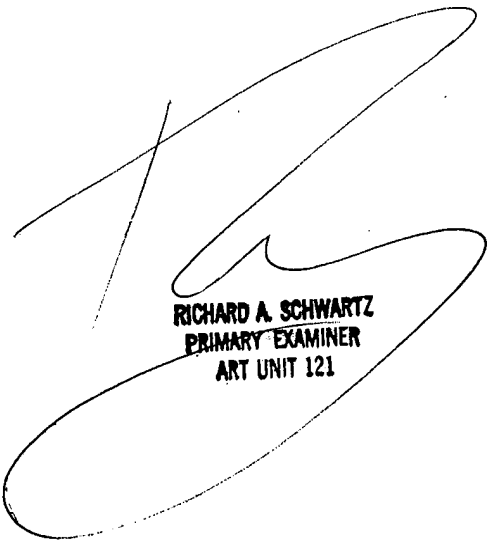
Claims 2 and 3 are rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 1 does not provide for phenyl-loweralkyl substitution on N, but claims 2 and 3 claim said substitution.

SCHWARTZ:wdh

A/C 703 557-3920

10/3/89



RICHARD A. SCHWARTZ
PRIMARY EXAMINER
ART UNIT 121